

REMARKS

Claims 1, and 4-8 are pending. All claims stand rejected. Applicant respectfully requests reconsideration of all rejections in the light of the amendments above and arguments below.

Claim Rejections-35 USC 112

Claims 1-8 have been rejected under 35 USC 112, second paragraph, on the grounds that the claims are indefinite as to derivatives. The examiner is reminded that claims 2 and 3 are no longer pending, having been canceled by the applicant on 6/5/2002. Therefore, re-rejection of these two claims is inappropriate.

Claims 1 and 8 have been amended (now new claim 9) so as to limit FK-506 to metabolites, but to continue to recite rapamycin metabolites and derivatives. The examiner is reminded that pharmacologically active derivatives of rapamycin are disclosed in the specification on p. 2, lines 20-25, in numbers sufficient to satisfy the criteria of In re Castelli, cited by the examiner in his previous Office Action.

These rejections should be withdrawn.

Written Description

Claims 1-8 are rejected under 35 USC 112, first paragraph, on an assertion that applicant has not provided sufficient examples of pharmacologically active derivatives and metabolites of FK-506 and rapamycin to enable the generic recitation in these claims. As noted above, claims 2 and 3 had been previously canceled.

The examiner is referred to amended claim 1 and replacement claim 9, and the explanation above. No recitation of derivatives of FK-505 remains in these claims.

It would be appropriate for the examiner to withdraw all of these rejections.

Double Patenting

The examiner continues his rejection of claim 8 over applicant's method patent USPN 6,410,340.

Replacement claim 9 has been now recites only the recombinant 8.4 kDa immunophilin and not the protein isolated from tissues. Hence, the present claim 9 does not read on the kit claim in the issued methods patent.

For this reason, examiner's rejection based on obviousness-type double patenting should be withdrawn.

Conclusions

Applicant submits that he has overcome all claim rejections, and that it would be appropriate to pass these claims to issuance.

Respectfully submitted,

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